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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,415	10/20/2000	Kia Silverbrook	NPA011US	1266

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER	
PHAM, THIERRY L	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,415	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-11,14 and 15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-11,14 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/15/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 10/13/05 and Petition for Revival of an abandoned application.
- Claims 1-3, 6-11, 14-15 are pending; claims 4-5,12-13 have been canceled.
- Amendment After Final filed on 8/15/05 has been entered.
- IDS filed on 8/15/05 has been considered and entered by the examiner.
- Petition has been granted and was mailed on 7/17/06.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 6, 8-9, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (U.S. 6330976), Ur (U.S. 6072871), and further in view of Markowitz (U.S. 5513254).

Regarding claim 1, Dymetman discloses a method of delivering a document directly to a user on demand (delivering digital documents directly to users in real-time basis, fig. 14-15, col.

19, lines 33-44, col. 28, lines 4-18, and col. 29, lines 28-38), said method comprising the steps of:

• formatting user requested information in the document (marking medium contains both coded data and human readable information, col. 7, lines 42-58 and col. 17, lines 35-40) so as to include one user interactive element (i.e. marking medium contains coded data which allows users to retrieve digital copy from remote system via using optical pointer 502, fig. 2), to allow the user to effect a response to the information, using a sensing device (optical pointer 502, fig. 2) for transmitting response back to a computer system (computer system, figs. 1-2;

• printing (col. 11, lines 55-60) the document, having advertising material in the advertising space (i.e. sales catalogue contains coded data which allows users to place an order by clicking on an item via using a pointer 502, col. 19, lines 33-42), together with coded data, said coded data being indicative of an identity of the document (identity of the document and zones within the coded marking medium, col. 3, lines 60-67 to col. 4, lines 1-23) and of the at least one interactive element.

Dymetman discloses a marking medium contains both coded data and human readable information (col. 14, lines 39-45, col. 35-39, and col. 19, lines 33-42) but fails to teach and/or suggest an inkjet printer prints (i.e. interactive printed document) the coded data at the same time as printing the document on the surface defining structure

Ur, in the same field of endeavor for printing, teaches an ink jet printer (printer 17, fig. 1) prints the coded data at the same time as printing the document on the surface defining structure (prints coded data 27 and document texts as shown in fig. 2 at the same time, col. 4, lines 41-47. the examiner herein interprets document as shown in fig. 2 is an interactive printed document).

However, the combinations Dymetman and Ur do not teach and/or suggest a method for identifying an advertising space outside an area of the document to be occupied by the information.

Markowitz, in the same field of endeavor for printing, teaches a method for identifying an advertising space outside (identifying an available white space within the document, fig. 4, abstract, col. 4, lines 45-57) an area of the document (i.e. below the text/graphic area, fig. 4c) to be occupied by the information.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ur and Dymetman as per teaching of Markowitz because of a following reason: (1) a sensing device for sensing invisible coded data incorporated within the document (Dymetman, col. 12, lines 65-67); (2) printing an advertisement on an available white space of the document preventing an overlap between an advertisement and the document (3) reduce hardware costs and time by printing both coded data and document data simultaneously.

Therefore, it would have been obvious to combine Markowitz, Dymetman, and Ur to obtain the invention as specified in claims 1 & 9.

Regarding claims 3 & 11, Markowitz further discloses a method as claimed in claim 1 wherein the information is formatted at a publication server (fax server, fig. 3, col. 6, lines 1-54) of the computer system and the method includes the publication server monitoring the said area and, once the space is identified, receiving the advertising material from an advertising server (selecting advertisement from database, fig. 2, col. 6, lines 54), for including in the document.

Regarding claims 6 & 14, Dymetman further teaches a method as claimed in claim 5, which includes printing the coded data to be substantially invisible (col. 11, lines 45-50 and col. 12, lines 60-67) in the visible spectrum.

Regarding claim 8, Dymetman further teaches a method as claimed in claim 1, wherein the sensing device (reference 502, fig. 1-2, fig. 8) includes an identification code (network address, fig. 8, col. 9, lines 24-45) specific to a particular user and the method includes monitoring (server, col. 5, lines 10-36) of the sensing device in the computer system.

Claims 2, 7, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz, Dymetman, and Ur as applied to claims 1 and/or 9 above, and further in view of Reiter (U.S. 6178411).

Regarding claims 2 & 10, the combinations of Markowitz, Dymetman, and Ur do not explicitly teach a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information.

Reiter, in the same field of endeavor for advertising distribution, teaches a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information (col. 2, lines 42-57 and col. 11, lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Markowitz, Dymetman, Ur as per teachings of Reiter because of a following reason: (1) printing advertisements/coupons on the back/reverse side of the document provides another option/way of distributing ads; therefore, increasing ads distribution flexibilities.

Therefore, it would have been obvious to combine Markowitz, Dymetman, Ur with Reiter to obtain the invention as s
pecified in claims 2 & 10.

Regarding claims 7 & 15, Reiter further teaches retaining a retrievable record of the printed document (print report, col. 5, lines 50-67).

Response to Arguments

Applicant's arguments with respect to claims 1 & 9 have been considered but are moot in view of the new ground(s) of rejection in view of different interpretations of previous applied arts of record.

- Regarding claims 1 & 9, the applicants argued the cited prior art of record (US 6330976 to Dymetman) fails to teach and/or suggest delivering of printed interactive document directly to users on demand via an inkjet printer.

In response, examiner notes that newly added limitations (interactive printed document via using inkjet printer) are not previously cited in claims 1 & 9. However, Ur (US 6072871) teaches an inkjet printer for delivering an interactive printed document (fig. 2) directly to a user on demand via using computer system (ref. 1 of fig. 1). It is well known in the art that printing system is based upon real-time basis (i.e. a document is printed as upon requested by the user). Document 19 as shown in fig. 2 of Ur contains textual/image information along with coded data is herein

interpreted as "interactive printed document". In addition, output document with different types printed coded data (i.e. barcode containing document ID) is well known.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6081261 to Wolff et al teaches an example of printed document containing encoded interactive barcode.
- US 5754308 to Lopresti et al teaches an example of printed document containing encoded interactive barcode.
- US 6137590 to Mori teaches an example of printed document containing encoded interactive barcode.
- US 6537324 to Tabata et al teaches an example of printed document containing encoded interactive barcode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

GABRIEL GARCIA
PRIMARY EXAMINER